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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,755	01/18/2002	Ching-Jun Su	B-4467 619464-5	3277
7590	11/17/2004		EXAMINER	
Richard P. Berg, Esq. c/o LADAS & PARRY Suite 2100 5670 Wilshire Boulevard Los Angeles, CA 90036-5679			CHAWAN, SHEELA C	
			ART UNIT	PAPER NUMBER
			2625	
DATE MAILED: 11/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/052,755	SU ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Sheela C Chawan	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 January 2002.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) 14 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***DETAILED ACTION***

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

2. Drawings filed on 11/16/01 have been approved by the examiner.

***Claim Objections***

3. Claim 15 is objected to because of the following informalities:

Claim 15, page 18, line 5, change ";" to -- . --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14, recites the limitation of " first control signal is used to disable access to the electronic system " in lines 2-3. It is unclear to examiner that the same first control signal is used for enable access to the electronic system as recited in claim 17. Please explain the reason for contradiction.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Diehl et al. (US 6,317,544 B1).

For claim 1, Diehl et al. disclose a fingerprint identity apparatus for an electronic system (Fig. 1), comprising:

an identity device (mobile computing terminal 30 in figure 1 is an identity device), having a fingerprint image sensor module (column 9, lines 61-66, fingerprint scanner 60 provides a sensor) coupled to a radio frequency (RF) module, wherein the RF module transmits fingerprint data, gathered by the fingerprint image sensor (60), by a wireless transmission protocol (column 9, lines 50-60, satellite connection 15 can provide a wireless communication);

a receiver module, receiving the fingerprint data transmitted by wireless transmission (fig 1, server 10 receives input fingerprint images transmitted by a mobile station 30, column 3, lines 3-15); and

a fingerprint identification module (central server 10 in figure 1 is used for fingerprint identification), coupled to the receiver module (column 3, lines 3-15) and a

memory module (fig 1, server 10 has fingerprint image database having predetermined fingerprint images plus some more database) to save predetermined fingerprint data, wherein the fingerprint identification module differentiates the fingerprint data (fig 1, a fingerprint matcher is used for differentiating and matching of fingerprint data), received by the receiver module, from the predetermined fingerprint data and controls the electronic system accordingly (column 10, lines 10-27).

For claim 2, Diehl et al. disclose the fingerprint identity apparatus, wherein the fingerprint identification module is a microprocessor (fig 1, central server 10 has a microprocessor inherently).

For claim 3, Diehl et al. disclose the fingerprint identity apparatus, wherein when the fingerprint data matches the predetermined fingerprint data; the fingerprint identification module enables access to the electronic system (column 10, lines 3 - 27; gaining access to the central server 10 corresponds to an access enable; see abstract).

For claim 4, Diehl et al. disclose the fingerprint identity apparatus, wherein when the fingerprint data does not match the predetermined fingerprint data; the fingerprint identification module disables access to the electronic system (column 10, lines 3-27; not gaining access to the central server 10 corresponds to a disable access; it is not obvious but inherited in the identification system).

For claim 5, Diehl et al. disclose the fingerprint identity apparatus, wherein when the fingerprint data does not match the predetermined fingerprint data, the fingerprint identification module turns off the electronic system (col. 10, lines 3-27; not gaining an access to the central server 10 corresponds to a disable access or turning off a system).

For claim 6, Diehl et al. disclose the fingerprint identity apparatus, wherein the electronic system is a notebook computer (column 9, lines 66-67).

For claim 7, Diehl et al. disclose the fingerprint identity apparatus, wherein a fingerprint identification module comprises a CPU and chipset of a notebook computer (column 9, lines 66-67).

For claim 15, see the rejection of claim 1 above.

As to claim 16, Diehl et al. disclose the identity recognition method, further comprising the step of transmitting a first control signal when the fingerprint data matches the predetermined fingerprint data (column 10, lines 10-27; abstract; matching of biometric data corresponds to transmitting of a first control signal for access enable).

For claim 17, see the rejection of claim 3 above.

For claim 18, see the rejection of claim 4 above.

For claim 19, see the rejection of claim 5 above.

For claim 20, see the rejection of claim 5 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions

covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (figures 1-2 and pages 1-2 of the specification) in view of Diehl et al. (US 6,317,544 B1).

As to claim 8, applicant's admitted prior art (figures 1-2 at column 1 line 20 to column 2 line 21 of the disclosure) discloses an identity recognition method for an electronic system, comprising the steps of:

setting up predetermined fingerprint data (step 201; page 2, lines 3-6);  
sensing fingerprint data (steps 202-203; page 2, lines 6-9);  
differentiating the fingerprint data from the predetermined fingerprint data (step 204; page 2, lines 11-12);  
transmitting a first control signal when the fingerprint data matches the predetermined fingerprint data (step 205; page 2, lines 12-14).

Applicant's admitted prior art does not disclose the use of wireless transmission. However in the same field of endeavor of fingerprint identification technique, Diehl et al disclose a mobile biometric identification system. The system uses a mobile access station 30 which includes a mobile computing terminal 35, a

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radiotelephone 40, a satellite connection 45, a land line connection 50, a color camera 55, and a fingerprint scanner 60 as shown in column 9, lines 61-66. The satellite connection provides a wireless communication to the system. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the admitted prior art by including the use of wireless transmission of fingerprint images. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the admitted prior art by the teaching of Diehl et al., for the purpose of providing a distributed, mobile biometric identification system and an architecture for rapidly identifying individuals using fingerprint and photographic data (as suggested by Diehl at column 1, lines 60-63).

As to claim 9, the admitted prior art discloses the identity recognition method wherein the fingerprint identification module is a microprocessor (figure 1 computer inherently uses microprocessor).

As to claim 10, the admitted prior art discloses the identity recognition method, wherein the first control signal is used to power up the electronic system (step 205, the computer enables access or turns on power).

As to claim 11, the admitted prior art discloses the identity recognition method, wherein the first control signal is used to enable access to the electronic system (step 205).

As to claim 12, the admitted prior art disclose the wireless identity recognition method further comprising the step of: transmitting a second control signal by wireless

transmission when the fingerprint data does not match the predetermined fingerprint data (step 206; page 2, lines 15-17).

As to claim 13, the admitted prior art discloses the wireless identity recognition method, wherein the second control signal is used to turn off the electronic system (step 206; page 2, lines 15-17).

***Other prior art cited***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fishbone et al. (US 5,222,152) disclose a portable fingerprint scanning apparatus for identification verification.

Catalano et al. (US 6,766,040 B1) disclose a system and method for capturing, enrolling and verifying a fingerprint.

Harkin (US 6,327,376 B1) discloses an electric apparatus comprising fingerprint sensing devices.

Setlak et al. (US 5,828,773) disclose a fingerprint sensing method with finger position indication.

Fishbine et al. (US 5,467,403) disclose a portable fingerprint scanning apparatus for identification verification.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela C Chawan whose telephone number is 703-305- 4876. The examiner can normally be reached on Monday - Thursday 8 - 6.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703-308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheela Chawan  
Patent Examiner  
Group Art Unit 2625  
November 14, 2004